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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,966

03/18/2005

Bruce Guy Dance

GJE-7522

9054

58899

7590

03/24/2009

MARTIN NOVACK

16355 VINTAGE OAKS LANE

DELRAY BEACH, FL 33484

EXAMINER

HEINRICH, SAMUEL M

ART UNIT

PAPER NUMBER

3742

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DELIVERY MODE

03/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,966	<b>Applicant(s)</b> DANCE ET AL.	
	<b>Examiner</b> Samuel M. Heinrich	<b>Art Unit</b> 3742	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35,37-40,42 and 43 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35,37-40,42 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-31 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 must clearly recite all process steps and not simply recited "using the method of claim 1".

The dependent claims contain the unclear description of the base claim 22.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-35, 37-40, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,861,407 to Volkmann et al in view of USPN 6,919,162 to Brennen et al in view of JP411044307A.

Volkmann et al describe (e.g., Abstract) pretreatment of a workpiece by using an energy beam to form projections on a surface and subsequently adhesively bond the treated workpiece to another workpiece. The projections improve the joint strength.

Volkmann et al describe (e.g., column 5, lines 30-36 and column 14, lines 36-40) "back and forth" translation in order to overlap the treatment of a pulse treated area by 150 percent.

Brennen et al disclose (column 3, line 56 through column 4, line 11) method of ablating features where the ablation is repeatedly offset and performed again in an overlap manner.

Brennen et al describe (column 12, lines 36-43) "step-and-repeat methods using a predefined laser spot ... i.e., cylinders or square, rectangular, diamond-shape cross-section 'towers', or the like."

JP411044307A describes use of a laser to form projections "formed into a mushroom shape, a loop shape".

Repeating the surface treatment described by Volkmann et al in a manner described by Brennen et al in order to get particular projection shapes as described by both Brennen et al and by JP411044307A would have been obvious at the time

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applicant's invention was made to a person having ordinary skill in the art in order to provide surfaces of workpieces having superior bonding capabilities.

The instant claimed elongate, rectilinear, and curved shapes would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the relative motion between the laser and workpiece and the resulting projection shape.

The instant claimed modification of the bulk structure of the workpiece and of the surface structure of the workpiece would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the dimensions and material of the workpiece.

Volkman et al describe back and forth treatment which inherently allows the melted material to at least partially solidify between formation of subsequent projections. The instant claimed particular timing would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the translation capability of the laser apparatus and depending on properties of the workpiece such as heat transfer.

Volkman et al describe (column 5, lines 4-15) the workpiece may be coated with a different material and some formation of an alloy during processing would be inherent.

Volkman et al describe (column 10, lines 13-22) use of a protective atmosphere or a mixture of gases which may enhance the treatment of the surface, i.e., chemical change.

Forming some loops would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the treatment of an area is overlapped repeatedly.

Volkman et al describe (column 4, lines 42-50) that the beam issuing from the laser can be altered, and describe (column 6, lines 42-44) that when a longer pulse time is used then the amount of laser energy needs to be increased. The instant claimed reduction of power for altering the projection shape would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the desired surface finish.

Volkman et al describe (column 2, lines 49-62) joining two surfaces which have been treated with the energy beam and it would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art that some projections and some apertures would mechanically engage.

Joining more than two bodies would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending the number of layers desired, for example joining to both sides of a metal workpiece.

Claims 22-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,861,407 to Volkman et al in view of USPN 6,919,162 to Brennen et al in view of JP411044307A as applied to claim 1 above, and further in view of JP62006449A.

JP62006449A describes a roughened spacer used for joining and the instant claimed process, at the time applicant's invention was made to a person having ordinary

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skill in the art, would have been obvious because more surface area provides more adhesion.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,861,407 to Volkmann et al in view of USPN 6,919,162 to Brennen et al in view of JP411044307A as applied to claim 1 above, and further in view of USPN 6,455,807 to Scott.

Scott describes (Abstract) control of a laser wherein one workpiece portion is allowed to cool while another portion is processed and the use of such control would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art in order to rapidly process complex work.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,861,407 to Volkmann et al in view of USPN 6,919,162 to Brennen et al in view of JP411044307A as applied to claim 1 above, and further in view of USPN 4,850,089 to Monfort et al.

Monfort et al describe (Claim 1) laser surface treatment which results in "forming an alloyed rim around each of said microcraters" and the use of an alloying step would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art in order to provide desirable material properties to the work.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,861,407 to Volkmann et al in view of USPN 6,919,162 to Brennen et al in view of JP411044307A as applied to claim 1 above, and further in view of USPN 6,709,985 to Goruganthu et al.

Goruganthu et al describe (column 5, lines 53-65) use of a "reduced power scan" in order to clear or smooth a target and the use of a particular power to smooth edges would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art.

Claims 1-35, 37-40, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,176,959 to Clarke in view of USPN 6,919,162 to Brennen et al in view of JP411044307A.

Clarke uses an energy beam to form projections on a surface and subsequently adhesively bond the workpiece to another workpiece. The projections improve the joint strength. Clarke does not describe timing steps in order to allow the melted material to at least partially solidify between formation of subsequent projections. Clarke describes (column 2, line 36+) forming an oxide layer.

Brennen et al disclose (column 3, line 56 through column 4, line 11) method of ablating features where the ablation is repeatedly offset and performed again in an overlap manner.

Brennen et al describe (column 12, lines 36-43) "step-and-repeat methods using a predefined laser spot ... i.e., cylinders or square, rectangular, diamond-shape cross-section 'towers', or the like."

JP411044307A describes use of a laser to form projections "formed into a mushroom shape, a loop shape".

Repeating the surface treatment described by Clarke in a manner described by Brennen et al in order to get particular projection shapes as described by both Brennen



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et al and by JP411044307A would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art in order to provide surfaces of workpieces having superior bonding capabilities.

The instant claimed elongate, rectilinear, and curved shapes would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the relative motion between the laser and workpiece and the resulting projection shape.

The instant claimed modification of the bulk structure of the workpiece and of the surface structure of the workpiece would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the dimensions and material of the workpiece.

Forming some loops would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the treatment of an area is overlapped repeatedly.

The instant claimed reduction of power for altering the projection shape would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the desired surface finish.

Joining more than two bodies would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending the number of layers desired, for example joining to both sides of a metal workpiece.

Repeating the microtexturization described by Clarke would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art in

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a manner similar to sanding the surfaces of two workpieces in order to get superior bonding.

The instant claimed particular timing would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art depending on the translation capability of the laser apparatus and depending on properties of the workpiece such as heat transfer.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,176,959 to Clarke in view of USPN 6,919,162 to Brennen et al in view of JP411044307A as applied to claim 1 above, and further in view of USPN 6,455,807 to Scott.

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JP62006449A describes a roughened spacer used for joining and the instant claimed process, at the time applicant’s invention was made to a person having ordinary skill in the art, would have been obvious because more surface area provides more adhesion.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M. Heinrich whose telephone number is 571-272-1175. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu B. Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samuel M Heinrich/  
Primary Examiner, Art Unit 3742